

Attorney Docket No. 6197.214-US
Kanstrup et al.
Serial No. 10/621,302 Filed July 17, 2003
Via Facsimile No.: 1 571-273-8300

RESPONSE

The examiner states in the Office Action Summary that claims numbered 1-10 are pending in the application; claims numbered 1 and 2 are rejected; and, claims numbered 3-10 are objected to.

35 U.S.C. §103(a) Rejection

The examiner has rejected claims numbered 1-2 under 35 U.S.C. §103(a) as being unpatentable over Romanenko, because a 7-nonyl species would be an obvious variant of the 7-heptyl and 7-(3-chloro-but-2-enyl) species excluded by proviso from the present claims. This rejection has been obviated by appropriate amendment.

Applicants have amended the alkyl groups of R^2 and R^4 to be C_1 . Thus, nonyl is no longer a possible alkyl group at the 7-position. The longest linear combination of alkyl groups for R^1 - R^2 - R^4 is butyl, a full five carbons shorter than nonyl (and three shorter than heptyl). Since Romanenko has no 7-butyl groups, Applicants submit that there is no motivation provided by Romanenko to arrive at the presently claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejection of claims numbered 1-2 under 35 U.S.C. §103(a).

35 U.S.C. §112, Second Paragraph Rejection

The examiner has rejected claims numbered 1-2 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the examiner states that "heteroaryl C_1 - C_3 alkylene" means that the heteroaryl group is not part of the R^1 - R^2 chain. Instead, the heteroaryl is a substituent.

Applicants completely disagree. However, in order to expedite prosecution, Applicants have amended "heteroaryl C_1 - C_3 alkylene to read "heteroarylene C_1 - C_3 alkylene" in order to further clarify the present claims. This amendment should leave absolutely no doubt that this group is "part of the chain."

Applicants respectfully request reconsideration and withdrawal of the rejection of claims numbered 1-2 under 35 U.S.C. §112, second paragraph.

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35 U.S.C. §112, First Paragraph Rejection

The examiner has rejected claims numbered 1-2 under 35 U.S.C. §112, first paragraph, for claiming subject matter that was not described in the specification. Specifically, the examiner states that if "heteroaryl C₁-C₃ alkylene" were part of the chain, then Applicants need to show that one of ordinary skill in the art would understand this meaning.

Applicants did not further explain the definition of "heteroaryl C₁-C₃ alkylene," now "heteroarylene C₁-C₃ alkylene," as they were and are of the position that one ordinary skill in the art would not misunderstand the definition. Since it seems to be the USPTO's goal to focus a great deal of effort on a simple definition, Applicants will further explain the definition of "heteroarylene C₁-C₃ alkylene."

The USPTO clearly understands that formula I shows a R² substituent on R¹. As a result, the USPTO requested that "ene" be added to the various groups of R¹. While completely unnecessary, Applicants acquiesced in order to expedite prosecution. Since every group of R¹ (except the un-substitutable groups, e.g., C=O and alkynylene) have a R⁴ substituent, Applicants submit it would be obvious to one of skill in the art that Applicants intended (a) for the entirety of each R¹ group to be part of the chain and (b) for any substituent on a R¹ group to be R⁴ and not some portion of the R¹ group itself.

This makes complete sense when one looks at the linearity of the definition of R¹. For example, R¹ recites arylene, then arylene-alkylene. In other words, R¹ recites a ring, following by a ring with an alkylene spacer. R¹ then recites heteroarylene, followed by heteroarylene-alkylene (a ring followed by a ring-spacer). It makes logical sense that R¹ is reciting a heteroarylene group as part of the chain, followed by a heteroarylene-alkylene, both of which are part of the chain. It is completely illogical to assume that heteroarylene-alkylene was intended to be an alkylene substituted by heteroaryl and R² when this would be a definition different from the rest of R¹.

Applicants submit that the USPTO's position here is illogical and untenable. One of ordinary skill in the art would not look to twist the definition of R¹ in order to arrive at a rejection. Instead, one of ordinary skill in the art would read the definition of R¹ in the context of the application and note that while there could be some confusion, there are only two options: heteroaryl in the chain or as a substitute on the alkylene. Since the latter option

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is inconsistent with the rest of the definition of R¹ as well as the R⁴ substituent (it recites heteroaryl), one of ordinary skill in the art would readily adopt the first definition.

Applicants respectfully request reconsideration and withdrawal of the rejection of claims numbered 1-2 under 35 U.S.C. §112, first paragraph.

The examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Rosemarie R. Wilk-Orescan
Registration Number 45,220
Novo Nordisk Inc.
100 College Road West
Princeton, NJ 08540
(609) 987-5969

Use the following customer number for all correspondence regarding this application.

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